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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,907	03/25/2004	George J. Franks JR.	82322	7404
22242	7590	02/10/2005	EXAMINER	
FITCH EVEN TABIN AND FLANNERY 120 SOUTH LA SALLE STREET SUITE 1600 CHICAGO, IL 60603-3406			LEE, JINHEE J	
			ART UNIT	PAPER NUMBER
			2831	

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/808,907

Applicant(s)

FRANKS, GEORGE J.

Examiner

Jinhee J Lee

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## **DETAILED ACTION**

### ***Oath/Declaration***

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

The filing date for the parent application 09/654,249 is incorrect.

### ***Claim Objections***

2. Claims 1, 9 and 18 are objected to because of the following informalities:

Claim 1 line 5, the phrase "the structure" has an error. Examiner suggests "one of the structures" instead to avoid insufficient antecedent rejection.

Claim 9 line 2, the phrase "at the at least a first hole" has an error. Examiner suggests "at the first hole" instead to avoid confusion.

Claim 18 line 2, the phrase "ends stop" has an error. Examiner suggests "end stop" instead to correct the error.

Claim 18 line 3, the phrase "the at least one stop" has an error. Examiner suggests "the at least one end stop" instead to avoid insufficient antecedent rejection.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 10-16, 19 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 10-16 recites the limitation "at least one projection". This is confusing. This "at least one projection" is different from the "at least one projection" of claim 4 as shown in the drawings and the specification. Examiner suggests using a different terminology for the "at least one projection" in these claims to clarify.

Claims 19 and 22 recites the limitation "hole". This is confusing. Examiner suggests using "third hole" to distinguish from the first and second holes.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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6. Claims 1-5, 8-9 and 17-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Malin (US006398596B1).

Re claim 1, Malin discloses a universal ground clamp for structures with different cross-sectional shape, comprising:

an elongated strap (11) defining at least a first hole (16, through hole) and a second hole (18, aperture); and

a securing stud mechanism (bolt assembly, 50, 51) to extend through at least the first hole (16) and the second hole (18) to attach the elongated strap about the structure;

the securing stud mechanism including a stud (50, 51) having a curved surface (on 51 for example) to engage the elongated strap with smooth transition (see figure 1 and column 3 line 64-65 according to the numbering in the middle).

Re claim 2, Malin discloses a universal ground clamp, wherein the stud includes a head (51, hex head) and a shank (50, shaft) and the head includes the curved surface (see figure 1).

Re claim 3, Malin discloses an electrical connector, wherein the elongated strap includes an abrasive surface (28) for engaging an electrically conductive structure (see figure 1).

Re claim 4, Malin discloses an electrical connector, wherein the abrasive surface includes at least one projection (unnumbered on holes 14, see figures 1 and 2).

Re claim 5, Malin discloses an electrical connector, wherein the at least one projection is formed by piercing the elongated strap with a pointed object (see column 3 lines 22-24).

Re claim 8, Malin discloses an electrical connector, wherein the at least one projection includes jagged and torn edges (grate like surface, see column 3 lines 22-24).

Re claim 9, Malin discloses an electrical connector, wherein the stud is captured at the at least a first hole and capable of being received by the second hole after the elongated strap has been positioned about at least a portion of an electrically conductive structure (see figures 1 and 2). Note that it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Re claim 17, Malin discloses an electrical connector, wherein the stud securing mechanism includes a sliding curved nut (20, U shaped bracket) slidingly supported on the elongated strap (see figures 1 and 2).

Re claim 18, Malin discloses an electrical connector, wherein the elongated strap includes at least one end stop (15, loop shape) and the sliding curved nut is maintained on the elongated strap by the at least one stop (see figure 1 and column 3 lines 52-54).

Re claim 19, Malin discloses an electrical connector, wherein the stud (51, 50) defines a hole (unnumbered with 56, threads) coaxial with the longitudinal axis of the stud (see figures 1 and 2).

Re claim 20, Malin discloses an electrical connector, wherein the head defines a bore (52, aperture) extending transversely to the longitudinal axis of the stud for receiving a ground wire (see figure 2).

Re claim 21, Malin discloses an electrical connector, wherein the bore extends completely through the head (see figure 2).

Re claim 22, Malin discloses an electrical connector, wherein the hole extends into the bore (see figure 2).

Re claim 23, Malin discloses an electrical connector, wherein the electrical connector includes a second stud (53, set screw) and the hole receives the second stud (see figures 1 and 2).

Re claim 24, Malin discloses an electrical connector, wherein the second stud may be rotatably shifted from a wire receiving position to a wire securing position (see figure 2 and column 4 lines 7-9).

Re claim 25, Malin discloses an electrical connector, wherein the bore may receive a wire when the second stud is in its wire receiving position and a wire may be secured therein when the second stud is in its wire securing position (see figure 2 and column 4 lines 7-9).

Re claim 26, Malin discloses an electrical connector, wherein the second stud includes a frusto-conical end portion (unnumbered, see figure 2).

Re claim 27, Malin discloses an electrical connector, wherein the elongated strap defines a plurality of holes (see figure 1).

Re claim 28, Malin discloses an electrical connector, wherein the plurality of holes are sized to receive the stud (see figure 1).

Re claim 29, Malin discloses an electrical connector, wherein the second hole is one of the plurality of holes (see figure 1).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malin.

Re claim 6, the device of Malin discloses the claimed invention except that the pointed object has an X-shaped point. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the X-shaped pointed object to make the abrasive surface, since it has been held that more than mere change of form or rearrangement of parts is necessary for patentability. *In re Span-Deck Inc. v. Fab-Con, Inc.*(CA 8, 1982) 215 USPQ 835. Furthermore, the applicant has also disclosed that variety of shaped (formed) objects can be used to form the at least one projection (see applicant's specification page 10 paragraph 0038).



Re claim 7, the device of Malin discloses the claimed invention except that the pointed object has a pyramidal shaped point. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the pyramidal shaped pointed object to make the abrasive surface, since it has been held that more than mere change of form or rearrangement of parts is necessary for patentability. *In re Span-Deck Inc. v. Fab-Con, Inc.*(CA 8, 1982) 215 USPQ 835. Furthermore, the applicant has also disclosed that variety of shaped (formed) objects can be used to form the at least one projection (see applicant's specification page 10 paragraph 0038).

9. Claims 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malin in view of Joseph (US006634063B2).

Re claim 10, Malin substantially discloses an electrical connector as set forth in claim 9 above. Malin does not explicitly disclose the first hole that includes at least one projection extending into the first hole and the stud captured within the first hole by the at least one projection. However, Joseph teaches of at least one projection (reinforced beads, see column 3 lines 30-31) extending into a hole and a stud captured within the hole by the at least one projection (see figures 1 and 2A). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the at least one projection of Joseph on the connector of Malin in order to capture the stud within the hole and reduce the possibility of strap failure.

Re claim 11, note that Joseph teaches wherein the at least one projection is integral to the elongated strap (see figure2A).

Re claim 12, the device of Malin as modified by teachings of Joseph discloses the claimed invention as set forth in claim 11 above with the at least one projection extending from the perimeter of the first hole and into the first hole (see figure 2A of Joseph). Malin/Joseph does not disclose that the at least one projection has a rectangular shape. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the projections of rectangular shape to provide reinforced area around the hole, since it has been held that more than mere change of form or rearrangement of parts is necessary for patentability. *In re Span-Deck Inc. v. Fab-Con, Inc.*(CA 8, 1982) 215 USPQ 835.

Re claim 13, note that Joseph teaches wherein the at least one projection (reinforced bead, column 3 lines 30-31) radially interferes with the stud and thereby captures the stud within the first hole (see figures 1 and 2A).

Re claim 14, note that Malin discloses the stud with a head (51) and a shank (50), and Joseph teaches of the at least one projection (reinforced bead, column 3 lines 30-31) that would radially interfere with the shank.

Re claim 15, note that Malin discloses the shank with a threaded portion (at 24A, the threaded opening), and Joseph teaches the at least one projection (reinforced bead, column 3 lines 30-31) that would radially interfere with threads of the threaded portion.

Re claim 16, the device of Malin as modified by teachings of Joseph discloses the claimed invention as set forth in claim 14 above with the shank including a threaded portion (at 24A, threaded opening of Malin) and a non-threaded portion (unnumbered on

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50, see figure 2 of Malin) located between the head and the threaded portion.

Malin/Joseph does not disclose that the at least one projection radially interferes with the non-threaded portion. It would have been an obvious matter of design choice to lengthen the none-threaded portion of the stud in order to have the at least one projection radially interfere with the non-threaded portion, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gudridge et al., Franks, Jr. and Orenick et al. are cited to show various components of a strap assembly.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jinhee J Lee whose telephone number is 571-272-1977. The examiner can normally be reached on M, T, Th and F at 6:30AM-5PM.

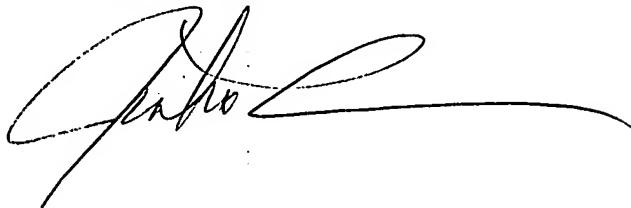
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean A Reichard can be reached on 571-272-2800 ext. 31. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jinhee J Lee  
Patent Examiner  
Art Unit 2831

jji

A handwritten signature in black ink, appearing to read 'Jinhee J Lee', with a long horizontal flourish extending to the right.